

REMARKS***Summary of the Response***

Upon entry of the Listing of Claims, claims 55 – 114 currently remain pending.

Summary of the Official Action

In the instant Office Action, the Examiner has indicated that claims 60 – 82 and 89 – 114 are allowable subject matter and would be allowable if presented in independent forms that include the features of their respective base claims. Further, the Examiner has rejected claims 55 – 59 and 83 – 88 over the art of record. By the present amendment and remarks, Applicant submits that the rejection have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Acknowledgment of Allowable Subject Matter

Applicant gratefully acknowledges the Examiner's indication that claims 60 – 82 and 89 – 114 contain allowable subject matter and would be allowable if presented in independent forms that include the features of their respective base claims. Further, Applicant notes that, while none of these claims are being presented into independent and allowable form at this time, any of these claims can be presented into allowable form in a subsequent response.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicant traverses the rejection of claims 55 – 60 and 83 – 88 under 35 U.S.C. § 102(b) as being anticipated by PROMONET et al. (European Patent No. EP 0 607 720) [hereinafter “PROMONET”]. The Examiner refers to claim 5 of PROMONET and asserts this provides sufficient evidence to show that the roller operates in the manner of a catalytic burner. Applicant traverses the Examiner's assertions.

Applicant initially wishes to clarify an apparent inadvertent statement in the Examiner's Response to Arguments on page 3 of the pending action. In this section, the Examiner states that Applicant has argued that PROMONET's claim 5 "provides evidence that promonet operates as a catalytic burner," when, in fact, Applicant has repeatedly argued that PROMONET does not operate as a catalytic burner, nor has the Examiner shown otherwise.

Applicant's independent claim 55 recites, *inter alia*, generating heat at least in part inside the roller by *catalytically combusting* a fuel with air or oxygen at least in some regions inside the roller, and Applicant's independent claim 83 recites, *inter alia*, a heating unit comprising *a catalyst arranged on an inside of the roller* to combust a fuel with air or oxygen. Applicant submits PROMONET fails to disclose at least the above-noted features of the invention.

As has been discussed at length throughout prosecution of this application, the present invention provides a catalyst on an inside of the roller. When a fuel with air or oxygen is fed to the catalyst inside the roller, an exothermic reaction occurs and heat is generated in the catalyst. Thus, the heat is generated through catalytic combustion of the fuel at least in part inside the roller.

PROMONET discloses a dryer cylinder in which combustible gas fed into a distribution chamber 7. The gas is ignited and then heats surface 6 to a very high temperature. Moreover, the heat produced in PROMONET radiates into annular space 14 to ultimately heat the dryer cylinder shell. As is well known, this type of heating is known as convection heating. Further, in contrast to the claimed invention, PROMONET fails to disclose a catalyst, and therefore, cannot even arguably disclose catalytically combusting a fuel with air or oxygen at least in some regions inside the roller, as recited in at least independent claim 55. Moreover, as PROMONET fails to disclose a catalyst, Applicant further submits the applied art fails to disclose a catalyst

arranged on an inside of the roller to combust a fuel with air or oxygen, as recited in at least independent claim 83.

While the Examiner asserts claim 5 of PROMONET provides evidence that PROMONET operates as a catalytic burner, Applicant notes PROMONET fails to disclose or claim a catalyst or catalytic burning. In an attempt to bolster the previous rejection over PROMONET, the Examiner asserts:

evidence of the roller operating in a manner of a catalytic burner is shown in claim 5 wherein the cylindrical surface (6) contains a means (19) for the ignition of combustible gases wherein the combustible gases flow into a distribution chamber (7) through a fibrous, porous and refractory material which aids in the combustion and thus acts as a catalyst, to produce a flame clinging to the surface, this surface lies in the space surrounding surface (5).

(Final Action, p. 2, ll. 17 – 22). However, Applicant submits that, as PROMONET neither discloses or refers to a catalyst in the specification or claims, the Examiner’s interpretation of PROMONET’s claim 5 is based upon Applicant’s own disclosure and not upon any reasonable reading of PROMONET’s disclosure.

Applicant notes that the Examiner has essentially ignored the recited “ignition means 19” of claim 5, since the ignition means 19 is contrary to the Examiner’s assertions of catalytic combustion. Unfortunately, the Examiner cannot ignore this element of PROMONET, which is disclosed in col. 3, lines 34 – 40 of PROMONET as an ignition means 19, mounted on and projecting from second cylindrical surface 6, forming a spark-plug capable of generating the combustion. According to PROMONET, the combustible gas passing over second surface 6 is ignited by the spark plug type device 19, whereby the flame catches on the entire outer periphery of second cylindrical surface 6. Thus, as PROMONET expressly recites ignition means 19 in claim 5 relied upon by the Examiner, Applicant submits there is no arguable disclosure of a catalyst or catalytic burning. Instead, PROMONET’s disclosure and even claim 5 describe, as

Applicant has maintained throughout prosecution of this application, convection heating through the ignition of the gas via a spark or flame. While the ignited flame clings to the surface 6, this does not change the nature of the ignition of the gas, nor does it arguably suggest catalytic burning or an exothermic reaction within a catalyst, as suggested by the Examiner.

As the Examiner has not identified specific disclosure in PROMONET of a catalyst or of catalytic burning, Applicant submits that the Examiner can only rely upon this document if catalytic burning is inherent within the disclosure of PROMONET. While the Examiner has not expressly asserted the catalytic burning as inherent in the disclosure of PROMONET, he has likewise not been able to identify any express disclosure of a catalyst or catalytic burning by PROMONET in the cited document.

Should the Examiner wish to present an anticipation rejection under 35 U.S.C. § 102(b) relying upon inherent disclosure, he is reminded that in order for inherency to be present *the Examiner has the burden of showing* that the result indicated by the Examiner is *the necessary result, and not merely a possible result*. *In re Oelrich*, 212 U.S.P.Q. 323 (CCPA 1981); *Ex parte Keith et al.*, 154 U.S.P.Q. 320 (POBA 1966). The fact that a prior art article *may* inherently have the characteristics of the claimed product is not sufficient. *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (BPAI 1986).

As the Board of Patent Appeals and Interferences states in *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463:

However, the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578,

212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). In order for inherency to be present it must be a necessary result, and not merely a possible result. *Ex parte Keith and Turnquest*, 154 U.S.P.Q. 320 (B.O.A. 1966).

However, as discussed above, the Examiner has not shown, nor can he, any disclosure by PROMONET that positively shows a catalyst and/or catalytic burning is a necessary result of the arrangement of PROMONET. Moreover, as PROMONET expressly discloses an ignition means 19 formed by a spark plug capable of generating the combustion to ignite the gas in the space, this provides evidence contrary to any assertions of inherency.

As PROMONET fails to disclose at least the above-noted features of at least independent claims 55 and 83, Applicant submit the applied art fails to show each and every feature of invention. Therefore, Applicant submits the Examiner has failed to establish an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b), such that this pending rejection is improper and should be withdrawn.

Further, Applicant submits that claims 56 – 60 and 84 – 88 are allowable over PROMONET at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further defines the invention. In particular, Applicant submits that PROMONET fails to show each and every recited feature recited in claims 56 – 60 and 84 – 88.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection of claims 55 – 60 and 83 – 88 under 35 U.S.C. § 102(b) and indicate that these claims are allowable.

Application is Allowable

Thus, Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and

respectfully requests the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

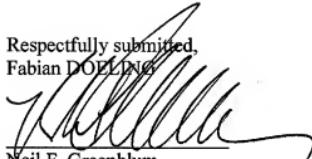
The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of claims 55 – 114. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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